

ESTTA Tracking number: **ESTTA206707**Filing date: **04/23/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Enterprise Rent-A-Car Company		
Entity	Corporation	Citizenship	Missouri
Address	600 Corporate Park Drive Saint Louis, MO 63105-4211 UNITED STATES		

Attorney information	Hadi S. Al-Shathir Thompson Coburn LLP One US Bank Plaza Saint Louis, MO 63101 UNITED STATES ipdocket@thompsoncoburn.com Phone:3145526000
----------------------	--

**Applicant Information**

Application No	77297923	Publication date	03/25/2008
Opposition Filing Date	04/23/2008	Opposition Period Ends	04/24/2008
Applicant	Blackwell, Kevin D. 805 Green Trail Farmington, MO 63640 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. All goods and services in the class are opposed, namely: Automobile dealerships featuring used automobiles
--

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1343167	Application Date	01/21/1982
Registration Date	06/18/1985	Foreign Priority Date	NONE
Word Mark	ENTERPRISE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 035. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 Automotive Fleet Management Services Class 037. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 Automotive Repair Services Class 039. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 Short-Term Rental and Leasing of Automobiles and Trucks Class 042. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 Automotive Dealership Services

U.S. Registration No.	2190147	Application Date	03/16/1992
Registration Date	09/22/1998	Foreign Priority Date	NONE
Word Mark	E ENTERPRISE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 automobile fleet management services Class 037. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 automobile repair services Class 039. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 short term rental services of automobiles and trucks; automobile leasing services Class 042. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 automobile dealership services		

U.S. Registration No.	2371192	Application Date	09/20/1999
Registration Date	07/25/2000	Foreign Priority Date	NONE
Word Mark	ENTERPRISE RENT-A-CAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1969/12/31 First Use In Commerce: 1969/12/31 vehicle rental and leasing services, and reservation services for the rental and leasing of vehicles		

U.S. Registration No.	2424137	Application Date	10/07/1999
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	WWW.ENTERPRISE.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1999/10/01 First Use In Commerce: 1999/10/01		

	vehicle rental and leasing services, and reservation services for the rental and leasing of vehicles
--	--

U.S. Registration No.	2458529	Application Date	10/07/1999
Registration Date	06/05/2001	Foreign Priority Date	NONE
Word Mark	ENTERPRISE.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1999/10/01 First Use In Commerce: 1999/10/01 vehicle rental and leasing services, and reservation services for the rental and leasing of vehicles		

U.S. Application No.	78958771	Application Date	08/23/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE		
Design Mark			
Description of Mark	"The mark consists of a green square to the left of a black rectangle. The letter E is white and green. The literal element ENTERPRISE is white."		
Goods/Services	Class 012. First use: vehicles, namely, automobiles, trucks, cars, land vehicles Class 035. First use: vehicle dealership services, namely, dealerships in the field of automobiles, trucks, cars, land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial purposes Class 037. First use: vehicle repair services; vehicle fleet management services, namely, vehicle repair and maintenance Class 039. First use: vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely, rental reservations for automobiles, trucks, cars, land vehicles		

U.S. Application No.	78958779	Application Date	08/23/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE RENT-A-CAR		
Design Mark			
Description of Mark	"The mark consists of a green square to the left of a black rectangle. The letter E is white and green. The literal element ENTERPRISE RENT-A-CAR is white."		
Goods/Services	Class 012. First use: vehicles, namely, automobiles, trucks, cars, land vehicles Class 035. First use: vehicle dealership services, namely, dealerships in the field of automobiles,		

	<p>trucks, cars, land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial purposes</p> <p>Class 037. First use: vehicle repair services; vehicle fleet management services, namely, vehicle repair and maintenance</p> <p>Class 039. First use: vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely, rental reservations for automobiles, trucks, cars, land vehicles</p>
--	---

U.S. Application No.	77070181	Application Date	12/22/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE		
Design Mark			
Description of Mark	The mark consists of a white letter "e" on a dark square field and a black "nterprise" on a white rectangular field to the right of the dark field.		
Goods/Services	<p>Class 012. First use: vehicles, namely, automobiles, trucks, cars, land vehicles</p> <p>Class 035. First use: vehicle dealership services, namely, dealerships in the field of automobiles, trucks, cars, land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial purposes</p> <p>Class 037. First use: vehicle repair services; vehicle fleet management services, namely, vehicle repair and maintenance</p> <p>Class 039. First use: vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely rental reservations for automobiles, trucks, cars, land vehicles</p>		

U.S. Application No.	77070178	Application Date	12/22/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE		
Design Mark			
Description of Mark	The mark consists of a white letter "e" on a grey square field and a white "nterprise" on a black rectangular field, which is positioned to the right of the grey field.		
Goods/Services	<p>Class 012. First use: vehicles, namely, automobiles, trucks, cars, land vehicles</p> <p>Class 035. First use: vehicle dealership services, namely, dealerships in the field of automobiles, trucks, cars, land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial</p>		

	<p>purposes</p> <p>Class 037. First use:</p> <p>vehicle repair services; vehicle fleet management services, namely, vehicle repair and maintenance</p> <p>Class 039. First use:</p> <p>vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely rental reservations for automobiles, trucks, cars, land vehicles</p>
--	--

U.S. Application No.	77240964	Application Date	07/27/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE		
Design Mark			
Description of Mark	The mark consists of a green square, and the letter "E" is in white and green in the green square and the literal element "ENTERPRISE" in white outlined by black to the right of the green square.		
Goods/Services	Class 039. First use: First Use: 2007/05/14 First Use In Commerce: 2007/05/14 vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely, rental reservations for automobiles, trucks, cars, land vehicles		

U.S. Application No.	77055263	Application Date	12/01/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE RENT-A-CAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use:</p> <p>vehicles, namely, automobiles, trucks, cars, land vehicles</p> <p>Class 035. First use:</p> <p>vehicle dealership services, namely, dealerships in the field of automobiles, trucks, cars, land vehicles; vehicle fleet management services, namely, tracking and monitoring vehicles for commercial purposes, and business consultation services relating to the management of a fleet of vehicles for commercial purposes</p> <p>Class 037. First use:</p> <p>vehicle repair services; vehicle fleet management services, namely, vehicle repair and maintenance</p> <p>Class 039. First use:</p> <p>vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely rental reservations for automobiles, trucks, cars, land vehicles</p>		

U.S. Application No.	77240958	Application Date	07/27/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	ENTERPRISE RENT-A-CAR
Design Mark	
Description of Mark	The mark consists of a green square, and the letter "E" is in white and green in the green square and the literal element "ENTERPRISE RENT-A-CAR" is in black to the right of the green square.
Goods/Services	Class 039. First use: First Use: 2007/05/30 First Use In Commerce: 2007/05/30 vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely, rental reservations for automobiles, trucks, cars, land vehicles

U.S. Application No.	77240924	Application Date	07/27/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENTERPRISE RENT-A-CAR		
Design Mark			
Description of Mark	The mark consists of a green square, and the letter "E" is in white and green in the green square and the literal element "ENTERPRISE RENT-A-CAR" is in white outlined by black to the right of the green square.		
Goods/Services	Class 039. First use: First Use: 2007/04/19 First Use In Commerce: 2007/04/19 vehicle rental and leasing services; and reservation services for the rental and leasing of vehicles, namely, rental reservations for automobiles, trucks, cars, land vehicles		

Related Proceedings	Also filing notice of opposition against Application No. 77/297,924
---------------------	---

Attachments	75804058#TMSN.gif ( 1 page )( bytes ) 75817449#TMSN.gif ( 1 page )( bytes ) 75817436#TMSN.gif ( 1 page )( bytes ) 78958771#TMSN.jpeg ( 1 page )( bytes ) 78958779#TMSN.jpeg ( 1 page )( bytes ) 77070181#TMSN.jpeg ( 1 page )( bytes ) 77070178#TMSN.jpeg ( 1 page )( bytes ) 77240964#TMSN.jpeg ( 1 page )( bytes ) 77055263#TMSN.jpeg ( 1 page )( bytes ) 77240958#TMSN.jpeg ( 1 page )( bytes ) 77240924#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.pdf ( 5 pages )(177127 bytes )
-------------	--

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Hadi S. Al-Shathir/
Name	Hadi S. Al-Shathir
Date	04/23/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ENTERPRISE RENT-A-CAR	)	
COMPANY,	)	
	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	Directed to App. No. 77/297,923
KEVIN D. BLACKWELL,	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

COMES NOW, Enterprise Rent-A-Car Company (“Opposer”), and pursuant to 15 U.S.C. §§ 1063 and 1068, 37 CFR § 2.101, hereby files its Notice of Opposition to U.S. Trademark Application Serial No. 77/297,923, filed by Kevin D. Blackwell (“Applicant”). In support of its Notice of Opposition, Opposer states as follows:

**PARTIES**

1. Opposer is a corporation organized and existing under the laws of Missouri with offices at 600 Corporate Park Drive, Saint Louis, Missouri 63105.
2. On information and belief, Applicant is a United States citizen residing at 805 Green Trail, Farmington, MO 63640.
3. On information and belief, Applicant is the owner of U.S. Trademark Application Serial No. 77/297,923 (“Application”) for the mark RENT-A-PRIZE in International Class 035 for *automobile dealerships featuring used automobiles* (“Applicant’s Services”).
4. The Application was published for opposition on March 25, 2008.

## **BACKGROUND**

5. Since at least as early as 1969, Opposer has continuously used in interstate commerce trademarks comprising solely or in part the term “ENTERPRISE” in connection with the renting and leasing of automobiles and automobile dealership services.

6. Opposer owns numerous United States trademark registrations for marks that incorporate the term “ENTERPRISE”, including: (1) U.S. Registration No. 1343167; (2) U.S. Registration No. 2190147; (3) U.S. Registration No. 2371192; (4) U.S. Registration No. 2424137; and (5) U.S. Registration No. 2458529. These registrations are valid and in good standing, and pre-date the filing date of the Application.

7. Opposer also own United States trademark applications for marks that incorporate the term “ENTERPRISE”, including: (1) U.S. Serial No. 78/958,771; (2) U.S. Serial No. 78/958,779; (3) U.S. Serial No. 77/070,181; (4) U.S. Serial No. 77/070,178; (5) U.S. Serial No. 77/240,964; (6) U.S. Serial No. 77/055,263; (7) U.S. Serial No. 77/240,958; and (8) U.S. Serial No. 77/240,924. The filing dates for Opposer’s applications pre-date the filing date of the Application.

8. Opposer has promoted and sold its services in interstate and intrastate commerce under its ENTERPRISE marks since long prior to any alleged use by Applicant of the mark shown in the Application. As a result of the use, promotion, and advertising of Opposer's ENTERPRISE marks, the marks have become well known to the trade and to the public, and have therefore acquired significant goodwill. Opposer's ENTERPRISE marks identify and distinguish its services from the services of others, and identify the source and origin of Opposer’s services to both the trade and the public.



9. Prior to Applicant's adoption of its mark, if any, Opposer's ENTERPRISE marks have been used and promoted in such a way as to create a public perception of the word ENTERPRISE as a family characteristic and as an indication of source, which characteristic is distinctive. Opposer's ENTERPRISE marks continue to be used and promoted in such a way. Accordingly, Opposer's ENTERPRISE marks constitute a family of marks, with Applicant's mark appearing to be a member thereof.

**COUNT I**  
**(Likelihood of Confusion)**

10. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 9.

11. On information and belief, Applicant has made no use of the mark shown in the Application, nor of any word, letter or design confusingly similar thereto, as a trademark or service mark, prior to the date of first use of Opposer's ENTERPRISE marks.

12. Applicant's registration and use of the mark shown in the Application is likely to cause confusion in the minds of the trade and of the public that Applicant's Services emanate from or are licensed, sponsored, or otherwise authorized by Opposer, when in fact they are not.

13. The mark shown in the Application so resembles Opposer's ENTERPRISE marks previously used in the United States by Opposer, and not abandoned, as to be likely, when applied to Applicant's Services, to cause confusion or to cause mistake or to deceive, and is an attempt to deceive the trade and the public and to benefit from the reputation and goodwill developed by Opposer.

14. Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- a) is likely to cause confusion, or to cause mistake, or to deceive;

- b) falsely suggests a connection with Opposer; and
- c) will damage Opposer's valuable goodwill in its ENTERPRISE marks.

15. For these reasons, Applicant is not entitled to registration of the mark shown in the Application.

**COUNT II**  
**(Dilution)**

16. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1-15.

17. Opposer's ENTERPRISE marks became famous as that term is defined in 15 U.S.C. § 1125 prior to any alleged use by Applicant of the mark shown in the Application.

18. Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- (a) will damage Opposer's valuable goodwill in its ENTERPRISE marks; and
- (b) will dilute the distinctive quality of Opposer's famous ENTERPRISE marks.

19. For these reasons, Applicant is not entitled to registration of the mark shown in the Application.

ACCORDINGLY, Opposer requests that the Opposition be sustained and that registration of the mark shown in the Application be refused.

Opposer authorizes the Commissioner for Trademarks to charge the fee of \$300 to Deposit Account 20-0823 for filing this Notice of Opposition. Opposer believes that no additional fees are due; however, the Commissioner for Trademarks is authorized to debit our Account 20-0823 for any additional fees.

Respectfully submitted,

THOMPSON COBURN LLP

By: /s/ Hadi S. Al-Shathir  
Thomas A. Polcyn  
Matthew J. Himich  
Hadi S. Al-Shathir  
One US Bank Plaza  
St. Louis, Missouri 63101  
(314) 552-6000 (Telephone)  
(314) 552-7000 (Facsimile)

Attorneys for Opposer,  
Enterprise Rent-A-Car Company

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this Notice of Opposition was sent via First Class Mail, postage prepaid, this 23<sup>rd</sup> day of April, 2008, to the following attorney of record for applicant:

Andrew B. Mayfield  
Armstrong Teasdale LLP  
1 Metropolitan Square, Suite 2600  
Saint Louis, MO 63102-2740

Attorneys for Applicant Kevin D. Blackwell

/s/ Hadi S. Al-Shathir